

Appl. No. 10/709250

Amdt. dated 05/11/2006

Reply to Office Action of 02/16/2006

REMARKS

Claims 1, 13, 27, 26, 29, 51, and 52 were objected to because of informalities. The informalities were corrected by amendment herein.

Claims 1, 2, 13, 20, 46, 48, 51 and 55-57 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 3,709,294 to Kilgore.

Claims 1-4, 46 and 48 stand rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,088,557 to Ricles et al.

Claims 5-9, 18, 21, 24, 27-38, 42, 43, 47, 49, 40, 53 and 54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kilgore or Ricles et al. in view of US Patent 6,336,408 to Parrott et al.

The Examiner acknowledged that claims 10-12, 19, 22, 23, 25, 26, 39-41, 44, 45, 52 and 58 would be allowable if rewritten in independent form.

Applicant respectfully amends claims 1, 6-11, 13, 46, 51, 53, 54 and 58 to clarify the invention. Applicant respectfully cancels claims 5, 18, 21, 24, 27-45 and 47-51. Applicant respectfully adds new claims 59-66.

Amended Independent Claim 1

Claim 1 has been amended to include the limitation of claim 5, now canceled. Amended claim 1 includes the limitation of "the pressure reducer including a heat sink adapted for rapidly reducing the temperature of the detonation gas." Claim 5 was rejected as obvious over Kilgore or Ricles et al. in view of Parrott et al.

Before a claim may be rejected under section 103, the examiner must establish a *prima facie* case of obviousness. See MPEP, Section 2142. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation . . . to modify the reference or combine the reference teachings. Second, there must be a

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reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP, Section 2143. Applicant respectfully submits that the examiner has failed to establish a *prima facie* case of obviousness. Therefore, the rejection must be withdrawn.

Kilgore teaches a collapsible chamber for the purpose of protecting a packer from the sudden increase in pressure from the detonation of perforation charges. Ricles et al. also discloses chambers for absorbing the pressure from the detonation of explosive charges. Neither Kilgore or Ricles et al. teach or suggest providing a heat sink or a motivation for a heat sink that can rapidly decrease the temperature of the detonation gasses.

Parrott et al. fails to teach a heat sink adapted to rapidly reduce the temperature of the detonation gasses. Further, Parrott et al. fails to teach or suggest the utilization for a heat sink after detonation of the explosive charges. Parrott et al. on the other hand teaches providing heat sinks to protect the heat sensitive components such as the explosive charges. (Parrott et al., col. 2, ll. 21-25). Instead of teaching a heat sink adapted to rapidly reduce heat of a detonation gas from explosive charges, Parrott et al. teaches protecting the explosive charges from heat.

The Examiner has failed to provide a motivation to combine the cited documents. The examiner has further failed to show all the claimed elements by combining the cited documents. In sum, the Examiner has failed to provide a *prima facie* showing of obviousness.

Amended Independent Claim 11

The Examiner acknowledged that claim 11 would be allowable if rewritten in independent form. Claim 11 has been rewritten to include the limitations of previous base claim 1. Applicant therefore requests that the rejection be withdrawn and that claim 11 and its dependent claims be noticed for allowance.

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Amended Independent Claim 46

Claim 46 has been amended to include the limitations of claim 47 and 50, "providing a heat sink" and "rapidly reducing the temperature of the detonation gas via the heat sink." Previous claims 47 and 50, now canceled, stand rejected as obvious in view of Kilgore or Ricles et al. in view of Parrott et al.

Applicant respectfully submits that the Examiner has failed to provide a *prima facie* case of obviousness. Therefore, Applicant requests that the rejection be withdrawn.

"The precise language of 35 U.S.C. 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103, Where such proof is lacking we see no necessity for resolving doubt in favor of the Patent Office's position" *In re Warner and Warner*, 154 USPQ 173, 177, 379 F.2d 1011 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1967).

"The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because *it may doubt* that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis." 154 USPQ at 178.

Applicant respectfully submits that the examiner has merely attempted to identify every limitation of Applicant's invention in the cited references and combine them without teaching or suggestion by the cited reference. "An examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability.' " *In re Rouffet*, 47 USPQ2d 1453,

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1457 (Fed. Cir. 1998) citing *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Amended Independent Claim 52

The Examiner acknowledged that claim 52 would be allowable if rewritten in independent form. Claim 52 has been rewritten to include the limitations of previous base claim 1. Applicant has further amended claim 52 to address the informality noted by the Examiner. Applicant therefore requests that the rejection be withdrawn and that claim 52 and its dependent claims be noticed for allowance.

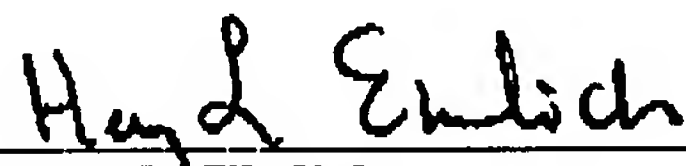
Conclusion

Applicant respectfully submits that the claims as amended herein are novel and unobvious. Applicant respectfully requests that the objections and rejections be withdrawn and a Notice of Allowance be mailed.

Respectfully submitted,
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DATE

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